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Ex parte DesOrmeaux (BdPatApp&Int) 25 USPQ2d 2040 (8/31/1992)

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Ex parte DesOrmeaux

**U.S. Patent and Trademark Office, Board of Patent Appeals and
Interferences**

25 USPQ2d 2040

Decided August 31, 1992

No. 92-2849

Headnotes

PATENTS

1. Patentability/Validity -- Anticipation -- Prior art (§ 115.0703)

Patentability/Validity -- Obviousness -- Relevant prior art -- In general (§ 115.0903.01)

Patentability/Validity -- Inventorship (§ 115.13)

Presence of common inventor, in otherwise-different inventive entities for patent and for patent application, does not preclude finding that patent's inventive entity is "another," within meaning of 35 USC 102(e), and that patent was available as prior art for purposes of 35 USC 103.

2. Patentability/Validity -- Specification -- Enablement (§ 115.1105)

Scope of enablement under 35 USC 112, first paragraph, varies with degree of complexity of subject matter involved, but there is no distinction in law as to enablement or description requirement based on whether subject matter is chemical or non-chemical.

Case History and Disposition:

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Appeal from final rejection of claims (C. Nessler, examiner; Kenneth M. Schor, primary examiner).

Application for patent filed by Thomas F. DesOrmeaux and another, identified only as "inventor 2," Feb. 22, 1990 (process and apparatus for recovery of oil cuttings). From final rejection of claims, applicants appeal. Affirmed.

[Editor's Note: Certain material was redacted from this opinion by the Board of Patent Appeals and Interferences. Asterisks are used to denote such omissions].

Attorneys:

Gregory C. Smith, of Pravel, Gambrell, Hewitt, Kimball & Krieger, Houston, Texas, for appellants.

Judge:

Before Calvert, vice chairman, Steiner, Pendegrass, Lynch, and W. Smith, examiners-in-chief.

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Opinion Text

Opinion By:

Steiner, examiner-in-chief.

This is an appeal from the final rejection of claims 13 through 19, which are all of the claims remaining in the application.

THE INVENTION

The subject matter on appeal is directed to a system for recovering oil from oil well cuttings, which-system comprises * * *.

Claims 13 and 19 are illustrative and read as follows:

13. An apparatus for drying, decontaminating and incinerating oil well cuttings containing water and hydrocarbons, the apparatus comprising: * * *

19. A method for preventing ignition of hydrocarbons that are removed from oil well cuttings through heating, the method comprising: * * *

APPLIED PRIOR ART

Reference A (A)

Reference B (B)

DeOrmeaux et al. (DesOrmeaux '283) 4,606,283 Aug. 19, 1986

THE REJECTIONS

(1) Claims 13 through 18 stand rejected under 35 U.S.C. 103 for obviousness as evinced by DesOrmeaux '283 in view of A.

(2) Claim 19 stands rejected under 35 U.S.C. 103 for obviousness as set forth in (1) above, further in view of B.

(3) Claims 13 through 19 stand provisionally rejected under 35 U.S.C. 103 for obviousness based on copending application Serial No. 07/* * * 1 in view of A and DesOrmeaux '283.

(4) Claims 13 through 19 stand provisionally rejected on the ground of double patenting of the obviousness type over claims 24 through 30 of Application Serial No. 07/* * * in view of A and DesOrmeaux '283.

Affirmed.2

OPINION

The Rejection Under 35 U.S.C. 103 Based Primarily Upon DesOrmeaux '283 (Rejections 1 and 2).

The examiner made certain factual determinations with respect to the teachings of each of the applied references. Specifically,

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the examiner determined that DesOrmeaux '283 discloses every feature of the claimed invention except for the * * * (claim 19). The examiner also determined that A discloses the conventionality of * * *, and that B discloses the concept of * * *. Appellants have declined to dispute any of these determinations. 3

The examiner then logically concluded that one having ordinary skill in the art would have been led to modify the system of DesOrmeaux '283 by * * *. The examiner also logically concluded that one having ordinary skill in the art would have been led to * * *. *In re Thompson*, 545 F.2d 1290, 192 USPQ 275 (CCPA 1976); *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976). In traversing the rejection, appellants also do not point to any error in the examiner's reasoning establishing the requisite motivation for the proposed combination of references to arrive at the claimed invention. 4

The only argument advanced by appellants on appeal in traversing this rejection is that DesOrmeaux '283 has the same effective filing date as the present application and, hence, is not available as prior art. Appellants argue that although the inventive entities of the present application (Thomas F. DesOrmeaux and Inventor 2) and DesOrmeaux '283 (Farrell P. DesOrmeaux, Thomas F. DesOrmeaux and Mark R. DesOrmeaux) are not the same, the presence of a common inventor (Thomas F. DesOrmeaux) precludes the determination that the inventive entity of DesOrmeaux '283 is "another" within the meaning of 35 U.S.C. 102(e) vis-a-vis the inventive entity of the present application.

According to appellants' representations in the response of November 27, 1990 (Paper No. 16), this application, filed February 22, 1990 (inventive entity -- Thomas F. DesOrmeaux and Inventor 2) is a continuation of now abandoned U.S. Patent Application Serial No. 07/* * * filed March 7, 1988 (inventive entity -- Thomas F. DesOrmeaux and Inventor 2), which is a Continuation-in-Part of now abandoned U.S. Patent Application Serial No. 06/* * *, filed December 29, 1986 (inventive entity -- Thomas F. DesOrmeaux), which is a Continuation-in-Part of U.S. Patent Application Serial No. 06/840,076, filed March 17, 1986, now U.S. Patent No. 4,726,301 (inventive entity -- Farrell P. DesOrmeaux, Thomas F. DesOrmeaux and Mark R. DesOrmeaux), which in turn is a Continuation-in-Part of U.S. Patent Application Serial No. 06/711,590, filed March 13, 1985, now U.S. Patent No. 4,606,283 (DesOrmeaux '283; inventive entity -- Farrell P. DesOrmeaux, Thomas F. DesOrmeaux and Mark R. DesOrmeaux).

The examiner factually determined that the effective filing date of the present application is the filing date of parent application Serial No. 07/* * * which is March 7, 1988, since that is the first application which contains adequate support under 35 U.S.C. 112 for the recited use of an inert gas, heating needs and graphite layer. *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). Appellants have not pointed out wherein support for such features under 35 U.S.C. 112 is found in any earlier filed related application or otherwise identified any error in this specific determination. 5 Since U.S. Patent Application Serial No. 07/165,197 was filed after the filing date of DesOrmeaux '283 (March 13, 1985), the examiner concluded that DesOrmeaux '283 is available as prior art under 35 102(e).

The examiner also determined, without dispute, that there is insufficient evidence of record to establish that the inventions claimed in DesOrmeaux '283 and in the present application were commonly owned at the time the invention in this application was made. The examiner then concluded that DesOrmeaux '283 is also available as prior art under 35 U.S.C. 102(f) and (g).

The reason advanced by appellants to support their position that the inventive entity of DesOrmeaux '283 is not "another" within the meaning of 35 U.S.C. 102(e) vis-a-vis the inventive entity of the present application stems from certain language appearing in *Ex parte Gilderdale*, 1990 Patent Appeals, Lexus 25 (BPAI Appeal No. 89-0352) 6 which, according to appellants' interpretation, is inconsistent with the published decision *Ex parte Mark*, 12 USPQ2d 1904 (BPAI 1989). We agree with the examiner

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that *Ex parte Gilderdale*, *supra*, is not inconsistent with *Ex parte Mark*, *supra*.

In *Ex parte Mark*, *supra*, the Board concluded that a patent which issued on the parent application and a patent which issued on a division of the parent application each constituted prior art under 35 U.S.C. 102(e), for purposes of 35 U.S.C. 103, with respect to a continuation-in-part application which listed an additional inventor, *i.e.*, the three inventors listed in each of the patents constituted an inventive entity different from the inventive entity composed of the same three inventors plus an additional inventor or "another" within the meaning of 35 U.S.C. 102(e). We find *Ex parte Mark*, *supra*, clearly consistent with prevailing case law. See, for example, *In re Fong*, 378 F.2d 977, 154 USPQ 25 (CCPA 1967); *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966); *Ex parte Glaser*, 161 USPQ 185 (Bd.App. 1967).

Ex parte Mark, *supra*, was decided in 1989 subsequent to the 1984 amendment of 35 U.S.C. 120 (Public Law 98-622, effective May 8, 1985) which enabled an application to obtain the benefit of the filing date of an earlier application when not all inventors named are the same as those named in the earlier application. Public Law 98-622 did not amend 35 U.S.C. 102(e). Had congress intended to change 35 U.S.C. 102(e) at that time, it would have done so explicitly.

In *Ex parte Gilderdale, supra*, the Board applied 35 U.S.C. 120 (as amended by Public Law 98-622) to the particular facts of that case. Since the applied reference (Hernandez), which issued on the parent application, had the same filing date as the rejected application, the Board concluded that Hernandez was not available as prior art under 35 U.S.C. 102(e) and, therefore, reversed the rejection. Clearly, the Board did not reverse the rejection on the theory that the invention described in the Hernandez patent was not invented by "another" within the meaning of 35 U.S.C. 102(e), notwithstanding the difference in inventive entities. ⁷ Thus, *Ex parte Gilderdale, supra*, is consistent with *Ex parte Mark, supra*, and does not hold that the term "another" in 35 U.S.C. 102(e) does not apply to inventive entities having one or more commonly listed inventors, e.g., that an inventive entity composed of A and B does not constitute "another" within the meaning of 35 U.S.C. 102(e) vis-a-vis an inventive entity composed of A and C. The Board's discussion of "another" was manifestly in the context of the amendment to 35 U.S.C. 120 which struck out "by the same inventor" (the opposite of "another") and inserted in lieu thereof which is filed by an inventor or inventors named in the previously filed application."

[1] We, therefore, find no error in the examiner's determination that the inventive entity of DesOrmeaux '283 (Farrell P. DesOrmeaux; Thomas F. DesOrmeaux; and Mark R. DesOrmeaux) is "another" within the meaning of 35 U.S.C. 102(e) vis-a-vis the inventive entity of the present application (Thomas F. DesOrmeaux and Inventor 2). Appellants' argument that Public Law 98-622 changing 35 U.S.C. 120 somehow, tacitly, also changed the words "he" in 35 U.S.C. 102(f) and "another" in 35 U.S.C. 102(g), is completely without foundation. We, therefore, agree with the examiner's conclusion that DesOrmeaux '283 is available as prior art under 35 U.S.C. 102(e), (f) and (g) for purposes of 35 U.S.C. 103.

In the Supplemental Answer, the examiner also held that DesOrmeaux '283 is available as prior art under 35 U.S.C. 102(b), inasmuch as DesOrmeaux '283 was patented on August 19, 1986, more than one year prior to the effective filing date of the present application which is March 7, 1988. We perceive no error in this holding.

In the responsive Reply Brief of May 18, 1992, appellants argue that DesOrmeaux '283 is not prior art under 35 U.S.C. 102(b) because it is incorporated by reference in the present application and, therefore, this application must enjoy the same filing date as to common subject matter. Appellants also argue that *In re van Langenhoven, supra*, does not apply because the rejection was based on a French patent, and that *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990), does not apply because it involved chemical subject matter.

[2] Suffice it to say, *Chester v. Miller, supra*, scotches appellants' argument anent the availability of DesOrmeaux '283 as prior art under 35 U.S.C. 102(b). We recognize that the scope of enablement under the first paragraph of 35 U.S.C. 112 varies with the degree of complexity of the subject matter involved. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970). However, we are unaware of any distinction in law as to the enablement or description requirements of the first paragraph of 35 U.S.C. 112 based on whether the subject matter is chemical or

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nonchemical. Appellants' Reply Brief does not elaborate on this issue or point to any specific error in the determinations underpinning the examiner's holding that DesOrmeaux '283 constitutes prior art under 35 U.S.C. 102(b).

Similarly, appellants' attempted distinction of *In re van Langenhoven, supra*, on the basis of the nationality of the applied reference is without support and inconsistent with the language of 35 U.S.C. 102(b). Appellants' hypothetical discussion with respect to amending claim 13 is irrelevant to the issues on appeal.

We completely agree with the examiner's conclusion that one having ordinary skill in the art would have found the claimed invention *prima facie* obvious based on the applied prior art for reasons previously discussed. Inasmuch as appellants declined to advance any argument with respect to objective evidence of non-obviousness, 8 we also agree with the examiner's ultimate legal conclusion that one having ordinary skill in the art would have found the claimed subject matter as a whole obvious within the meaning of 35 U.S.C. 103. Accordingly, this rejection is affirmed.

The provisional Rejections Under 35 U.S.C. 103 on the Ground of Double Patenting of the Obviousness Type (Rejections 3 and 4).

These rejections are affirmed for the reasons advanced by the examiner on appeal.

Appellants contend that the provisional rejection under 35 U.S.C. 103 must fall because DesOrmeaux '283 is not available as prior art. For reasons previously discussed, we disagree with appellants' position that the inventive entity of Farrell P. DesOrmeaux, Thomas F. DesOrmeaux, and Mark R. DesOrmeaux, is not "another" within the meaning of 35 U.S.C. 103 vis-a-vis the inventive entity of Thomas F. DesOrmeaux and Inventor 2 of the present application. As to the provisional double patenting rejection, appellants argue that there is no indication that the copending application will issue as a patent. We refer to *Ex parte Karol*, 8 USPQ2d 1771 (BPAI 1988) and *Ex parte Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966) as to the propriety of imposing a provisional rejection on the ground of double patenting of the obviousness type.9

Appellants' general denial of the lack of motivation for the proposed combinations does not apprise us of any particular reversible error in the examiner's rationale, and no reversible error is apparent.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989). **AFFIRMED**

Footnotes

Footnote 1. Copending application Serial No. 07/* * * is involved in Appeal No. 92-2850 decided concurrently herewith.

Footnote 2. On page 4 of the Brief, appellants state that the appealed "claims do not stand or fall together." However, the examiner determined that the appealed claims do stand or fall together, inasmuch as appellants did not advance any argument addressed to the patentability of any particular claim as required by 37 CFR 1.192(c)(6). See *Ex parte Ohsumi*, 21 USPQ2d 1020 (BPAI 1991); *Ex parte Schier*, 21 USPQ2d 1016 (BPAI 1991). In the responsive Reply Brief, appellants did not dispute the examiner's determination.

Footnote 3. The failure of an appellant to present an argument before the Board of Patent Appeals and Interferences, prior to the submission of a request for reconsideration, constitutes a waiver of such an argument. *In re Kroekel*, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986).

Footnote 4. Appellants' general denial of the requisite motivation is not particularly informative as to why appellants consider the examiner's specific reasoning faulty.

Footnote 5. See footnote 3.

Footnote 6. The language apparently relied on by appellants appears on page 5 of that decision and reads as follows:

What the examiner fails to appreciate is that the term "another" in Section 102(e) has been modified significantly by the amendments to Section 120 in Public Law 98-622.

Footnote 7. We refer to the ultimate full paragraph on page 5 of the decision wherein the Board stated:

. . . since Hernandez has the same effective date as the instant application, it is not available as a reference, and thus, the rejections cannot be sustained.

Footnote 8. Cf. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

Footnote 9. See, also, *Ex parte Bartfeld*, 16 USPQ2d 1714 (BPAI 1990), affirmed on other grounds, 17 USPQ2d 1885 (Fed. Cir. 1991), with respect to the propriety of imposing a provisional rejection under 35 U.S.C. 103.

- End of Case -

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